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ANNOP MAGNESS  
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**APR 19 2005**

**OFFICE OF PETITIONS**

**ON PETITION**

In re Application of :  
Annop Magness :  
Application No. 09/942,855 :  
Filed: August 29, 2001 :  
Attorney Docket No. :

This is a decision on the renewed petition under 37 CFR 1.137(a), first filed on March 14, 2005, and in duplicate on April 13, 2005, to revive the above-identified application.

The renewed petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to reply to the "Notice of Allowability" (the "Notice") mailed March 24, 2004, which set a statutory period for reply of three-month from its mailing date. No response was received within the allowable period, and the application became abandoned on June 25, 2004. A Notice of Abandonment was mailed on August 18, 2004. A petition under 37 CFR 1.137(a) was filed on November 8, 2004, and dismissed by a decision mailed December 10, 2004. The decision allowed an extendable period for reply of two months from its mailing date. The instant renewed petition was filed on March 14, 2005. No request for an extension of time within the first month was noted, but is required in order to make the instant renewed petition timely.

A grantable petition under 37 CFR 1.137(a)<sup>1</sup> must be accompanied by: (1) the required reply,<sup>2</sup> unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3).

<sup>1</sup>As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

<sup>2</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

**The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.**

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”<sup>3</sup>

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”<sup>4</sup>

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”<sup>5</sup>

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”<sup>6</sup>

**The standard**

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”<sup>7</sup>

The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”<sup>8</sup> Nonawareness of a PTO rule will not constitute unavoidable delay.<sup>9</sup>

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<sup>3</sup>Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff’d without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”)

<sup>4</sup>Commissariat A L’Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

<sup>5</sup>Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

<sup>6</sup>Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

<sup>7</sup>Id.

<sup>8</sup>See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

<sup>9</sup>See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel’s nonawareness of PTO rules does not constitute “unavoidable” delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a

**Application of the standard to the current facts and circumstances**

In the instant renewed petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner again asserts that petitioner was out of town and relied on a friend to receive notices from the Patent and Trademark Office and mail responsive correspondence and was also injured during the relevant period.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reason petitioner's argument must necessarily fail are addressed below.

Petitioner is again advised that the evidentiary standard for a petition under 37 CFR 1.137(a) requires that petitioner demonstrate that petitioner acted reasonably and prudently in the prosecution of the application and treated the prosecution of the application as his most important business. The instant renewed petition does not establish that petitioner was prudent in relying on a friend to deliver to petitioner the Notice of Allowance and Notice of Allowability. If petitioner was going to be out of town for an extended period, petitioner certainly had the option of forwarding mail to the petitioner's location or of contacting the Patent and Trademark Office to ascertain the status of the application and of correspondence sent out in the application. Petitioner's reliance on a friend, who presumably had no knowledge of the importance of the papers he was being asked to receive and forward, is arguably imprudent and does not indicate that petitioner treated the application's prosecution as his most important business.

As to petitioner's claim of being injured during the relevant period—beginning March 24, 2004, until the filing of the grantable petition—it is noted that petitioner admits that the alleged injury to petitioner's back did not occur until November 8, 2004. Thus, the injury occurred well after the period for response to the Notice of Allowability expired—that period being three-months from the mailing date (March 23, 2004) of the Notice of Allowability. It is further noted that the doctor's note provided with the instant renewed petition clearly states that petitioner was not seen during the period relevant to this petition. Based on the aforementioned, it is concluded that the injury sustained on November 8, 2004, is irrelevant to the abandonment of the application that occurred for failure to respond to the Notice of Allowability mailed March 23, 2004. The renewed petition is dismissed, accordingly.

**Petitioner is strongly encouraged to file a petition to revive based on unintentional abandonment under 37 CFR 1.137(b) (enclosed) as petitioner is unlikely to establish that the entire delay in responding to the Notice of Allowability was unavoidable given the facts presented.** A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$1,500.00 for a large entity and \$750.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

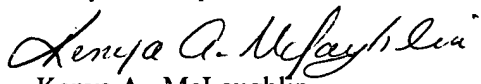
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specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

By mail:                      Mail Stop Petitions  
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                                    Alexandria, VA 22313-1450

By facsimile:              (703) 872-9306  
                                    Attn:    Office of Petitions

Telephone inquiries should be directed to the undersigned (571) 272-3222.

  
Kenya A. McLaughlin  
Petitions Attorney  
Office of Petitions

Enclosure: Form PTO/SB/64